REMARKS

This paper is in response to the Office Action dated April 11, 2006. Claim 1 is pending in the present application.

Applicants have amended the application to address the Examiner's objections regarding written support for the subject matter. No new matter is added by the amendments. Applicants respectfully request the entry of the amendments and reconsideration of the application in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. §102

Claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by Australian (AU) Plant Breeder's Rights (PBR) Application 1998018 and Grant No. 1983. The Examiner argued that both the application and grant indicated that the claimed plant was first sold in Australia in 1998, which is more than one year prior to the filing date of the instant application, thus enabling the cited art and anticipating the subject matter. However, Applicants respectfully disagree as the first sale date indicated by the PBR application and grant refers to the first sale of the **fruit only** rather than that of the propagating material. The harvested B74 mangoes are monoembryonic and therefore cannot be used to propagate the variety as claimed.

The Australian PBR laws require disclosure of the date of first sale of propagating **or** harvested material. Accordingly, the PBR application provides the 1998 date for the first sale of the fruit. However, this date is not relevant to an analysis under §102, because that analysis must couple a nonenabling printed publication with some other form of enablement (e.g., public availability of the variety). In the present case, the 1998 sale of the fruit simply is not enabling of the B74 variety. Therefore, any rejection under §102 based upon the 1998 sale is fundamentally flawed and must be withdrawn.

Claim 1 was also rejected under 35 U.S.C. §102(b) as being anticipated by the Queensland Government announcement of Dr. Tony Whiley's retirement in view of AU PBR 1983 and further in view of Applicant's remarks made March 26, 2004 indicating that propagating material was commercialized by One Harvest and its sub-licensees as early as November 1999. Applicants are unaware of any remarks made on March 26, 2004 and therefore

assume that the Examiner is referring to the Applicants' remarks in the previous response mailed on January 20, 2006.

With respect to the announcement of Dr. Tom Whiley's retirement, this document only describes the achievements of Dr. Tony Whiley in developing the B74 mango. However, there is no mention or suggestion that the B74 mango or B74 propagating material was sold or made publicly available by the announcement publication date of February 15, 2002. Therefore, the announcement does not anticipate the claimed subject matter, and Applicants respectfully request the withdrawal of this rejection.

Regarding Applicants' prior remarks referencing One Harvest, Applicants wish to point out that the referenced date of November 29, 1999 is the date of signing of an agreement to commercialize the **B74 mango fruit only**. The agreement does not equate in any way to public availability of the propagating material. Propagating material was distributed, but not sold, to selected growers for the purpose of growing and selling the **mango fruit only**. By March 2003, existing B74 sub-licenses had only been granted to a select group of small-scale growers, and those growers could only use the propagating material in accordance with the Agreement and only grow the plant in agreed-upon areas. Growers were expressly forbidden from sub-licensing to other parties, and interested members of the public could not in any way obtain such a sub-license. All propagating material had to be destroyed at the end of the Agreement.

In addition, due to the many limitations and restrictions placed upon sub-licensees, the Queensland Department of Primary Industries filed a Notification with the Australian Competition and Consumer Commission, in order to verify that the restrictions imposed upon the growers were not in breach of the relevant sections of the "Third Line Forcing" rules of the Australian Trade Practices Act. The Notification was required because the Agreement obligated the sub-licensed growers to only grow the agreed number of trees and to sell the fruit from those trees to a specified third party.

Applicants respectfully note that all of these points of evidence not only fail to establish or imply public availability of the variety, but instead are plainly inimical to any notion of public availability. The Examiner's assertions as to public availability are directly contradicted by these facts.

The ongoing business conduct of One Harvest with respect to B74 sub-licensees further illustrates the fact that the variety is not and has never been made available to the general public. The Examiner is respectfully requested to consider the following facts:

- One Harvest has refused to enter into a sub-license agreement with particular growers on several occasions. On that basis, those growers are not permitted to grow B74 mangoes.
- One Harvest has terminated certain sub-license agreements on the basis of poor performance, and the B74 trees were destroyed when these sub-licenses were terminated.
- One Harvest has transferred certain sub-licenses when orchards have been sold from the previous owner to the new owner to allow the new owner the right to continue growing B74.
- Growers can only grow the agreed number of B74 trees and must provide all fruit from the trees to One Harvest for sale purposes.
- Growers are not free to sub-license to other parties, nor can any interested member of the public obtain a sub-license.
- By March 2003, only about 47,000 B74 mango trees had been planted in Australia under grower Agreements with One Harvest. This may be compared to the commercial mango plant population in Australia of over 1.1 million trees in 2003.

Furthermore, as discussed above, the B74 mango fruit is monoembryonic and cannot be used to propagate the claimed variety. Therefore, although the fruit was commercialized, Applicants maintain that the agreement does not confirm public availability of the claimed subject matter more than one year prior to the instant application. Accordingly, this rejection under §102 is likewise based upon a nonenabling disclosure that is not coupled with enabling public availability. Applicants therefore respectfully submit that the rejection must be withdrawn.

Claim Objections Under 35 U.S.C. §112

The Examiner made several objections to the disclosure under 37 C.F.R. 1.163(a) and 35 U.S.C. §112, first paragraph, due to the lack of a full, clear and complete description of the

subject matter and the characteristics which define said subject matter and which also distinguish it from related known cultivars and antecedents in the disclosure. The Office Action listed the objections to the disclosure separately in paragraphs B, C and F. These objections have been addressed by the amendments to the specification and are self-evident in the marked-up copy showing the amendments.

Regarding paragraph B, the Examiner objected to the description of Figure 1 in which the Applicants' description indicated the horizontal arrangement of varieties while the referenced Figure contained photographs arranged vertically. In response to the Examiner's objection, Applicants have amended the specification to indicate that the 'Kensington Pride' cultivar is illustrated on the bottom of Figure 1 and the 'R2E2' cultivar is illustrated at the top of Figure 1.

Regarding paragraph C, the Examiner requested disclosure as to whether the parent, rootstock and/or comparison cultivars 'Sensation', 'Kensington Pride', 'R2E2' and 'Keitt' have been patented in the U.S., are currently the subject(s) of a pending U.S. plant patent application(s), or are unpatented. Applicants herein respond that the aforementioned comparison cultivars are unpatented. In addition, Applicants have amended the specification to indicate that the comparison cultivars are unpatented.

Regarding paragraph F, the Examiner objected to the vague skin color comparisons between the claimed subject matter and the comparison cultivars 'Kensington Pride' and 'R2E2' in the specification and requested clarification on the distinction between the varieties. The Examiner was not easily able to distinguish between the "red and yellow" skin color of the claimed subject matter and the "yellow and red" skin color of the 'Kensington Pride' and 'R2E2' comparison cultivars as set forth in the specification. In response to the Examiner's objections, Applicants have amended the specification to distinguish the skin colors of the claimed subject matter, 'Kensington Pride,' and 'R2E2.' The predominant skin color of the claimed subject matter is now recited as being "approximately equal amounts of yellow and red blush (approximately 30% to 55% red blush)" whereas the predominant skin color of the 'Kensington Pride' and R2E2' is "yellow with a small proportion of red blush." Applicants have also amended the disclosure in Table 1 to better illustrate the distinctions in skin color between the claimed subject matter and the comparison cultivars.

In view of the foregoing amendments and remarks, Applicants respectfully request withdrawal of these objections.

Conclusion

In view of the amendments and arguments presented above, Applicants submit that the present application is in condition for allowance and respectfully request the same. If any issues remain, the Examiner is cordially invited to contact Applicants' counsel at the number provided below in order to resolve such issues promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 8/10/06

By: Sanjivpal S. Gill

Sanjivpal S. Gill
Registration No. 42,578
Attorney of Record
Customer No. 20,995
(415) 954-4114

2821915_2
080906